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In re Application of  
KLOWER et al

Application No.: 09/355,422

PCT No.: PCT/EP97/06592

Int. Filing Date: 26 October 1997

Priority Date: 29 January 1997

Attorney Docket No.: 29462-025

For: AUSTENITIC NICKEL-CHROMIUM-  
MOLYBDENUM-SILICON ALLOY WITH HIGH  
CORROSION RESISTANCE TO HOT  
CHLORIDE-CONTAINING GASES AND  
CHLORIDE

NOTIFICATION

This application is before the PCT Legal Office for consideration of matters arising under 35 U.S.C. 371.

#### BACKGROUND

On 26 November 1997, applicants filed international application PCT/EP97/06592 which claimed a priority date of 29 January 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 30 July 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 30 June 1998, prior to nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 29 July 1999.

On 28 July 1999, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*: the basic national fee; preliminary amendment; and a declaration. The transmittal letter was also accompanied by what is listed as "[a] copy of the originally filed international application (in German and English)"; "[a] copy of the international application as published (in German and English)"; "[a] copy of the substitute pages (in German) of the application"; and "[a] translation into English of substitute pages of the application."

On 20 August 1999, the United States Designated/Elected Office mailed a

NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) which accorded the above-identified application 35 USC 102(e) and 371(c) dates of 28 July 1999.

On 23 October 2000, in an amendment filed in response to an Office Action mailed 20 April 2000, applicants submitted a "Substitute Translation of the International Application, including the Amendments of April 1, 1999 made during the International Phase". The Remarks section of the 23 October 2000 response states that: "It appears that a page from the Verified Translation on July 28, 1999, may have been inadvertently excluded. It appears that the translation of page 7 of the German language application was inadvertently excluded."

#### DISCUSSION

In view of the "substitute translation" and remarks submitted in the 23 October 2000 response, it is apparent that the translation filed 28 July 1999 was not sufficient. Thus, the requirements of 35 U.S.C. 371(c) for entry into the national stage in the United States of America were not completed as of the 35 U.S.C. 102(e) and 371 dates indicated in the NOTIFICATION OF ACCEPTANCE mailed 20 August 1999. Accordingly, the 20 August 1999 NOTIFICATION OF ACCEPTANCE is hereby VACATED.

It does not appear that applicants have yet submitted an accurate translation of the international application as filed. For example, on page 3 and in claim 1 of all of the translations submitted 28 July 1999, the element Nb appears in an amount of a maximum of 0.5% but neither this amount of the element nor the element itself appears on page 3 or in claim 1 of the international application as published. Thus, contrary to the transmittal letter of 28 July 1999, a copy of the "originally filed international application" in English and a copy of the "international application as published" in English have not been submitted. It is also apparent that the translation filed 23 October 2000 is not an accurate translation of the international application as filed since, according to the response filed 23 October 2000, it includes the amendments made during preliminary examination.

An accurate translation of the international application as filed is required in order to comply with 35 U.S.C. 371. See, e.g., 37 CFR 1.495(c)(1). Thus, the requirements of 35 U.S.C. 371(c) for entry into the national stage in the United States of America have not yet been completed. Applicants must file such a translation. It is suggested that applicants also re-submit the translation filed 23 October 2000 such that it complies with 37 CFR 1.125. Among other things, 37 CFR 1.125 [as amended, 65 FR 54673, 08 Sept. 2000] requires a "marked up version of the substitute specification showing all the changes (including the matter being added to and the matter being deleted from) to the specification of record." Here, the specification of record will be the translation of the international application as filed (which has not yet been submitted).

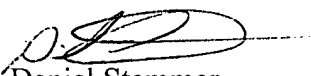
It is also noted that the Transmittal Letter filed 28 July 1999 contains imprecise terminology. Item (5) lists a "copy of the *substitute pages* (in German) of the application" and item (6) lists a "translation into English of *substitute pages* of the application" (emphasis added). However, these pages should have been identified as either Article 34 amendments or as Annexes to the International Preliminary Examination Report rather than as "substitute" pages.

#### CONCLUSION

Applicants are required to file 1) a translation of the international application as filed into English, and 2) the processing fee of \$130 under 37 CFR 1.492(f) for submitting a translation of the application later than thirty months from the priority date, within a time limit of ONE (1) MONTH from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

The time period set in the communication mailed by the United States Patent and Trademark Office on 03 January 2001 (Paper No. 9) is restarted to coincide with the time limit set forth herein.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Affairs.



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